

REMARKS

The Office Action mailed October 28, 2004 has been reviewed and carefully considered.

Claims 1-21 are pending in this application.

Applicants' gratefully acknowledge the indication in the Office Action that Claims 10-13 are allowed.

Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al. (hereinafter "Smith") in view of Gerszberg et al. (hereinafter "Gerszberg"). Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al. (hereinafter "Smith") as modified by Gerszberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al. (hereinafter "Desmond"). Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Braun et al. (hereinafter "Braun") in view of Gerszberg. Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Braun as modified by Gerszberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond. Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schlachman et al. (hereinafter "Schlachman") in view of Gerszberg. Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schlachman as modified by Gerszberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond. The rejections are respectfully traversed.

The present invention is directed to the problem of delivering directory data or other information directly to a telephone or other device **over a digital signal line network** (see Applicants' specification, page 1, line 33 to page 2, line 1). The admitted prior art involves either looking up directory information in the Yellow or White Pages or by calling the information service over an analog signal line network and speaking with an operator (see Applicants' specification, page 1, lines 20-24).

It is quite noteworthy that the cited prior art references that mention directory information do NOT involve a Digital Subscribers Line (DSL) telephone network. For example, the Examiner has explicitly stated in the Office Action that "Smith/Braun/Schlachman differs from the claimed invention in not disclosing the

telecommunication device being connected to a DSL telephone network” (Office Action, dated May 7, 2004, pages, 3, 5, and 7)(emphasis added).

To further support his position, in particular, to provide a reference showing a DSL telephone network, the Examiner has relied upon Gerszberg, which is directed to a videophone **BLOCKER** (Gerszberg, Title). However, the Applicants respectfully assert that Gerszberg is non-analogous art and, further, that Gerzberg teaches away from the present invention and is, thus, not applicable to a rejection of the pending claims.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143. Smith is directed to an “automatic transfer of electronic directory entries from directory assistance service to a directory within an electronic communication device (Smith, Title). Braun is directed to a “system and method for providing directory information over a telephony network using ADST” (Braun, Title). Schlachman is directed to an “apparatus for enabling a telephone user to obtain directory information” (Schlachman, Title). In contrast, Gerszberg is directed to a videophone blocker (Gerszberg, Title). In particular, Gerszberg discloses “[a] videophone with selective privacy control of a caller’s transmitted image” (Gerszberg, Abstract).

As noted in the MPEP, “[t]he determination of what arts are analogous to a particular claimed invention is at times difficult. It depends upon the **necessary essential function or utility of the subject matter covered by the claims**, and not upon what it is called by the applicant” (MPEP §904.01(a)). It is respectfully pointed out to the Examiner that not a single claim in Gerzberg recites a “digital subscriber line (DSL)” as relied upon by the Examiner to support the claim rejections.

Moreover, “[i]n order to rely on a reference as a basis for rejection of applicants’ invention, the reference must either be in the field of applicants’ endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned” (MPEP §2141(a), citing “in re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, while Smith, Braun, Schlachman are respectively directed to TRANSFERRING directory entries, PROVIDING directory information, and OBTAINING directory information, Gerszberg is dissimilarly directed to BLOCKING data, and thus, **TEACHES AWAY** from any combination with any of Smith, Braun,

and Schlachman. That is, one seeking to transfer, provide, or obtain data to/for a telephone user would not consult patents on blocking data to a telephone (or videophone) user, as the two concepts (providing data versus blocking data) diverge 180 degrees.

In the prior response, the Applicants' pointed out to the Examiner that a prior art reference must be considered in its entirety, i.e., as a whole, INCLUDING PORTIONS THAT WOULD LEAD AWAY FROM THE CLAIMED INVENTION. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (*see also*, MPEP §2141.03)). The Examiner has responded by stating that the "Applicants' statement that a reference must be considered in its entirety, e.g., as a whole, on page 11 is duly noted. Applicants' remarks center on the title of Gerzberg being directed to a videophone blocker and it being different from the other applied references having titles related to directory thereby concluding that Gerzberg is not pertinent prior art is contrary to applicants' statement that a reference must be considered in its entirety, e.g., as a whole" (Office Action, dated October 28, 2004, p. 9). However, the Examiner has failed to see past the first portion of the quote provided by the Applicants to the second portion thereof, namely that PORTIONS OF A PRIOR ART REFERENCE THAT WOULD LEAD AWAY FROM THE CLAIMED INVENTION MUST BE CONSIDERED (see MPEP section and case law cited above). The fact that the title and the claims of Gerzberg are directed to the BLOCKING of video (or providing an indication of such) in a videophone cannot and should not be ignored, and certainly teaches away from technologies and approaches that transfer, provide, or obtain data to/for a telephone user. Accordingly, Gerzberg teaches away from the Applicants' invention and is non-analogous art with respect to the Applicants' invention.

Moreover, there certainly would not be any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings when one reference involves providing data previously unavailable and the other reference involves blocking available data. Thus, it is not proper to rely upon a tangential portion of a reference where that reference teaches away and is non-analogous art with respect to a claimed invention. Accordingly, Applicants again respectfully assert that Gerszberg is non-

analogous art that teaches away from the claimed invention and its use is inappropriate in any rejections of the pending claims.

Accordingly, Applicants respectfully assert that none of Smith, Braun, Schlachman, or Gerszberg, either taken singly or in any combination, disclose all of the limitations recited in independent Claims 1 and 14. Moreover, assuming *arguendo* that Gerszberg even discloses the limitations relating to DSL in Claims 1 and 14 for which the Examiner relied, such limitations cannot be shown in Gerszberg because Gerszberg is non-analogous art and, thus, cannot be combined with any of Smith, Braun, Schlachman. Thus, Claims 1 and 14 are patentably distinct and nonobvious over the cited references for at least the reasons set forth above.

Claims 2-13 depend either directly or indirectly from Claim 1 and, thus, contain all of the limitations of Claim 1. Claims 15-21 depend either directly or indirectly from Claim 14 and, thus, contain all of the limitations of Claim 14. Thus, Claims 2-13 and Claims 15-21 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claims 1 and 14, respectively. Reconsideration of the rejection is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of October 28, 2004 be withdrawn, that pending claims 1-21 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to Applicants' Deposit Account No. 07-0832.

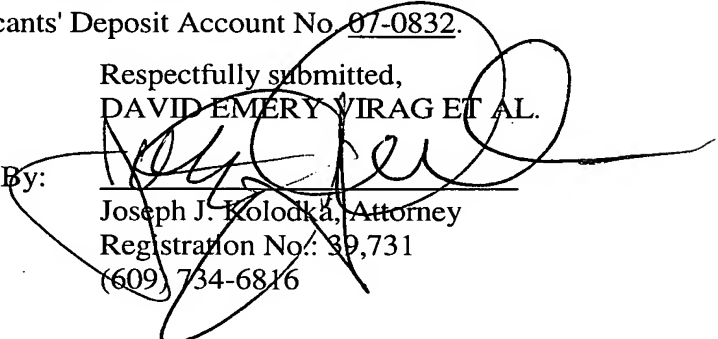
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